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08/941,602    09/30/97    MIZE

J    42765

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IM52/0302

EXAMINER

NOLAN, S

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

03/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
**08/941,602**

Applicant(s)  
**MIZE et al**

Examiner  
**Sandra Nolan**

Group Art Unit  
**1772**



☒ Responsive to communication(s) filed on Jan 5, 2001

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-7, 18, 20, and 22-35 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-7, 18, 20, and 22-35 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 15

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Claims***

1. Following entry of the amendment submitted on January 5, 2001 (Paper No. 20), claims 1-7, 8, 20 and 22-35 are under consideration. The non-elected claims are 8-17, 19 and 21.

### ***Information Disclosure Statement***

2. The information disclosure statement submitted on June 27, 2000 (Paper No. 15) was considered by the examiner before the office action mailed on July 5, 2000 (Paper No. 17).

Another copy of the initialed form PTO-FB-A820 is enclosed.

### ***Rejection Withdrawn***

3. The 35 USC 102 rejection of claim 18, as anticipated by British specification 654,460, set out in paragraph 4 of Paper No. 17, is withdrawn in view of the amendments in Paper No. 20.

### ***Rejections Maintained***

4. The 35 USC 103 rejection of claims 1-7 and 22-25 as unpatentable over Brady et al (WO-96/00688) in view of Williams et al (US 5,540,646), as set out in paragraph 6 of Paper No. 17, is maintained for the reasons set out there.

5. The 35 USC 103 rejection of claims 20 and 33 as unpatentable over Williams et al (US 5,540,646), as recited in paragraph 7 of Paper No. 17, is maintained for the reasons stated there.

6. The 35 USC 103 rejection of claims 26-30 (now claims 18 and 26-30), as explained in paragraph 8 of Paper No. 17, is maintained for the reasons given there.

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7. The 35 USC 103 rejection of claims 31, 32, 34, and 35 as unpatentable over Brady et al in view of Williams et al, as set forth in paragraph 9 of Paper No. 17, is maintained for the reason stated in that paragraph.

***Response to Arguments***

8. Applicant's arguments filed in Paper No. 20 have been fully considered but they are not persuasive.

The arguments in Paper No. 20 center on structural and/or processing features found in some of Applicants' claims.

It is noted that the "lie flat" feature that Applicants argue throughout their response is recited in only one of the independent claims now under consideration--i.e., claim 18. Also, the process limitations argued are not found along with the "lie flat" feature in any of the claims.

Applicants' arguments concerning the 35 USC 102 rejection are rendered moot by the withdrawal of that rejection. See paragraph 3, *supra*.

Most of Applicants' arguments concern the process by which their bag/patch composites are produced. The Examiner reminds Applicants that process limitations are not generally convincing of patentability unless those limitations have been shown--via convincing objective evidence-- to result in unexpected properties/results over the prior art cited.

The bag/patch composites of Brady may be configured/sealed in slightly different ways than are Applicants'. However, those differences are not as "stark" as Applicants would have one believe. The Examiner reminds Applicants that positioning alone--when that positioning results in

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obvious results--will not render an article patentable. Placing a patch on a bag for boned meat in a location that will reinforce the bag so that a bone does not penetrate the combined bag/patch multilayered wall is deemed an obvious way to design a bag for packaging bone-in meats.

Furthermore, the process by which the articles are made is the subject of a separate invention and is not before the Examiner now. Note the restriction requirement in the March 30, 1999 Office Action (Paper No. 4).

The Examiner notes that Applicants have characterized various references as "teaching away from" and being "directly contrary to" their invention. Such arguments are unconvincing when, as here, the overall concept of positioning the patch in a place that will strengthen the patched bag effectively is an obvious one.

The combined references suggest the claimed invention except for the size and positioning of the patches. It would have been an obvious matter of design choice to use larger patches on the bags, since such a modification would have involved a mere change in the size of the component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Also, the positioning of the patch in a location on the bag that is likely to be subject to stress because of a bone protruding from the meat or other product in the bag would be an obvious way to strength the bag. Without more, that positioning is deemed an obvious way to modify the bag/patch combinations that are suggested by the prior art applied in Paper No. 17.

***Final Rejection***

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra M. Nolan, whose telephone number is (703) 308-9545. The examiner can normally be reached on Monday through Thursday from 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on (703) 308-4251. The fax phone number for the art unit is (703) 305-5408. The telephone number for the receptionist is (703) 308-0661.

  
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March 1, 2001  
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HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772 3/1/01